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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,202	08/17/2001	Boris S. Elman	00-8024	4924
32127 7590 04/03/2007 VERIZON PATENT MANAGEMENT GROUP 1515 N. COURTHOUSE ROAD, SUITE 500 ARLINGTON, VA 22201-2909			EXAMINER ANWAH, OLISA	
			ART UNIT	PAPER NUMBER
			2614	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/03/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@VERIZON.COM

Office Action Summary	Application No. 09/932,202	Applicant(s) ELMAN ET AL.	
	Examiner Olisa Anwah	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 15,17 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14,16,18-24 and 26-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The exhibit submitted on 2/8/7 under 37 CFR 1.131 is insufficient to establish a conception of the invention prior to the effective date of the Bulthuis, Sun and Langhart references. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). For instance, claim 1 specifically recites, the plurality of data management functions includes a function for translating the two-way conversion data stored in the remote storage device. However the exhibit does not disclose that the plurality of data management functions includes a function for translating the two-way conversion data stored in the remote storage device. Similarly, claim 6 requires that the secondary device interface is a wireless interface that allows data transfer between the memory and the secondary device. Yet the exhibit does not disclose that the secondary device interface is a wireless interface that allows data transfer between the memory and the secondary device. Additionally, claim 19 claims that the

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translating function is conducted by a text translation service that converts at least a portion of the text data from a first language to a second language. Nonetheless, the exhibit does not state the translating function is conducted by a text translation service that converts at least a portion of the text data from a first language to a second language. To the extent that the Applicant insists on maintaining the Declaration, the Examiner respectfully requests that the Applicant point out where the exhibit teaches all the claimed limitations as presently claimed.

Regarding the remarks filed on 2/8/7, Applicant is absolutely correct. It is not necessary for an accompanying exhibit to support all claim elements. However, MPEP § 715.07 explicitly requires that the declaration must clearly explain which facts or data Applicant is relying on to show completion of his or her invention prior to the particular date. More specifically, Applicant declare that prior to 2/27/01, they conceived of:

...the plurality of data management functions including functions for editing, translating, searching, linking, downloading, editing, playing back, converting, sending,

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archiving, and deleting the two-way conversation data stored in the remote storage device;

...wherein the secondary device interface includes an attachment that physically connects the memory to the secondary device or is a wireless interface that allows data transfer between the memory and the secondary device;

...wherein the translating function is conducted by a text translation service that converts at least a portion of the text data from a first language to a second language...

Yet, the declaration does not clearly explain which facts or data Applicant is relying on to show completion of these limitations prior to 2/27/01. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Consequently, the § 103 rejections submitted on 10/18/2006 are maintained.

2. The evidence submitted is also insufficient to establish due diligence. Although Applicant provided multiple statements

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regarding the issue of diligence on pages 10 and 11 of the response filed on 2/8/7, Applicant does not submit any evidence to support these statements. For instance, on page 10 of the response, Applicant states that activities of the legal counsel includes at least one telephone conference on January 30, 2001. However, Applicant does not provide any evidence of the alleged telephone call. According to MPEP § 715.07, "it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence" (emphasis added). Because Applicant has not shown any evidence of facts establishing diligence, the § 103 rejections submitted on 10/18/2006 are maintained.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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4. Claims 1-5, 8-12, 16, 21-24 and 30 are rejected under 35 U.S.C § 103(a) as being unpatentable over Takagi et al, U.S. Patent Application Publication No. 2004/0137945 (hereinafter Takagi) combined with Walker et al, U.S. Patent No. 6,529,602 (hereinafter Walker) in further view of Bulthuis, U.S. Patent No. 2003/0032447 (hereinafter Bulthuis).

Regarding claim 1, Takagi discloses an apparatus (see Figure 1) for transmitting, receiving and recording two-way conversation data between at least two remote locations, comprising:

- a wireless communication device (101);

- a memory (110) coupled to the wireless communication device for storing two-way conversation data in digital form;

- a device interface for communicatively coupling the wireless communication device to a remote storage device (109/106) and sending the stored two-way conversation data to the remote storage device; and

- a user interface configured to allow a user of the wireless communication device to access, by way of a wireless network, the two-way conversation data stored in the remote storage device, the user interface including a plurality of data management functions that allows the user of the wireless communication device to manage, by way of the wireless network,

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the two-way conversation data stored in the remote storage device (paragraphs 0052, 0058 and 0067).

Takagi doesn't explicitly teach the plurality of data management functions includes a function for editing the two-way conversation data stored in the remote storage device. However Walker discloses this limitation (see column 5). As a result, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Takagi with the modification function of Walker. This modification would have improved the convenience of Takagi by allowing a user to use the dialing keys to modify a recording as suggested by Takagi (see paragraph 0083).

With further respect to claim 1, the combination of Takagi and Walker fails to explain the plurality of data management functions includes a function for translating the two-way conversion data stored in the remote storage device. On the other hand, Bulthuis teaches this limitation (see the transcribing feature described at paragraph 0010). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Takagi and Walker with the translating function of Bulthuis. This modification would have improved the system's

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versatility by allowing conversations to be saved as text files as suggested by Bulthuis.

Regarding claim 2, see Figure 1 of Takagi.

Regarding claim 3, see paragraph 0036 of Takagi.

Regarding claim 4, see Figure 1 of Takagi.

Regarding claim 5, see Figure 1 of Takagi.

With respect to claim 8, Takagi discloses a system for managing two-way conversation data occurring between at least two remote locations over a network, comprising:

- a wireless communication device (101);

- a memory (110) coupled to the wireless communication device for storing two-way conversation data in digital format;

- a storage location (109/106) outside the memory;

- an interface between the memory and the storage location for transferring the two-way conversation data from the memory to the storage location (paragraph 0018); and

- a user interface that allows a user of the wireless communication device to access, by way of a wireless network the two-way conversation data in the storage location, the user interface including a plurality of data management functions that allows the user of the wireless communication device to

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manage, by way of the wireless network, the two-way conversation data stored in the storage location (paragraphs 0067 and 0068).

Takagi doesn't explicitly teach the plurality of data management functions includes a function for editing the two-way conversation data stored in the storage location. However Walker discloses this limitation (see column 5). As a result, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Takagi with the modification function of Walker. This modification would have improved the convenience of Takagi by allowing a user to use the dialing keys to modify a recording as suggested by Takagi (see paragraph 0083).

With further respect to claim 8, the combination of Takagi and Walker fails to explain the plurality of data management functions includes a function for translating the two-way conversion data stored in the remote storage device. On the other hand, Bulthuis teaches this limitation (see the transcribing feature described at paragraph 0010). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Takagi and Walker with the translating function

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of Bulthuis. This modification would have improved the system's versatility by allowing conversations to be saved as text files as suggested by Bulthuis.

Claim 9 is rejected for the same reasons as claim 2.

Regarding claim 10, see paragraph 0037 of Takagi.

Regarding claim 11, see Figure 1 of Takagi.

Regarding claim 12, see Figure 1 of Takagi.

Regarding claim 16, see paragraphs 0067 and 0068 of Takagi.

Regarding claim 21, see paragraph 0013 of Takagi.

As per claim 22, Takagi discloses a system for managing two-way conversations between a first communication device (101) located at a first location and a second communication device (111) located at a second location remote from said first location, said two-way conversations occurring over a network having at least one storage location (109/106), wherein at least one wireless communication device can be connected to said network (see Figure 1), comprising:

a data interface between said at least one wireless communication device and said at least one storage location for transferring data derived from said two-way conversations from

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said at least one storage location to said at least one wireless communication device (paragraphs 0067 and 0068);

a user interface, including at least one user-controllable data management function that allows a user of said at least one wireless communication device to access, by way of said network said data in said at least one storage location, said user interface including a plurality of data management functions that allows the user of said at least one wireless communication device to manage, by way of said network, said data in said at least one storage location (paragraphs 0067 and 0068).

Takagi doesn't explicitly teach the plurality of data management functions includes a function for editing the two-way conversation data stored in said at least one storage location. However Walker discloses this limitation (see column 5). As a result, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Takagi with the modification function of Walker. This modification would have improved the convenience of Takagi by allowing a user to use the dialing keys to modify a recording as suggested by Takagi (see paragraph 0083).

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With further respect to claim 22, the combination of Takagi and Walker fails to explain the plurality of data management functions includes a function for translating the two-way conversion data stored in the remote storage device. On the other hand, Bulthuis teaches this limitation (see the transcribing feature described at paragraph 0010). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Takagi and Walker with the translating function of Bulthuis. This modification would have improved the system's versatility by allowing conversations to be saved as text files as suggested by Bulthuis.

Regarding claim 23, see Figure 1 of Takagi.

Regarding claim 24, see paragraph 0036 of Takagi.

Regarding claim 30, see paragraph 0013 of Takagi.

5. Claims 6 and 13 are rejected under 35 U.S.C § 103(a) as being unpatentable over the combination of Takagi, Walker and Bulthuis in further view of Sun et al, U.S. Patent Application No. 2002/0160751 (hereinafter Sun).

With respect to claim 6, the combination of Takagi, Walker and Bulthuis fails to show the secondary device interface is a

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wireless interface that allows data transfer between the memory and the secondary device. Nevertheless Sun discloses this limitation (paragraph 0028). Consequently it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Takagi, Walker and Bulthuis with the interface disclosed by Sun. This modification would have improved the flexibility of Takagi by allowing users to transfer data via a variety of mechanisms as suggested by Sun.

Claim 13 is rejected for the same reasons as claim 6.

6. Claims 7, 14, 18, 26 and 27 are rejected under 35 U.S.C § 103(a) as being unpatentable over Takagi combined with Walker, Bulthuis and Sun in further view of Kek et al, U.S. Patent No. 6,072,860 (hereinafter Kek).

On the matter of claim 7, Takagi shows the claimed downloading, archiving and sending functions (see paragraphs 0067-0068). Takagi does not explicitly teach the claimed editing, playing back and deleting functions. However Walker clearly reveals these procedures (observe column 5). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Takagi with the editing, playing back, sending and deleting functions

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disclosed by Walker. This modification would have improved the user friendliness of Takagi by allowing users to take any necessary actions as suggested by Takagi.

Further regarding claim 7, the combination of Takagi and Walker doesn't explicitly discuss the converting limitation. On the other hand, Bulthuis teaches this limitation (see paragraph 0010). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Takagi and Walker with the converting function of Bulthuis. This modification would have improved the system's versatility by allowing conversations to be saved as text files as suggested by Bulthuis.

Further regarding claim 7, the combination of Takagi, Walker and Bulthuis does not teach the claimed linking limitation. But Sun shows this function (see Figure 5). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Takagi, Walker and Bulthuis with the linking feature of Sun. This modification would have improved the system's convenience by allowing the recorded file to be associated with other stored files as suggested by Sun (see Figure 5).

Further regarding claim 7, the combination of Takagi, Walker, Bulthuis and Sun doesn't show the claimed limitation of searching the two-way conversation data stored in the storage location. Nonetheless, Kek discloses this feature (see Figure 6). Hence it would have been obvious to one of ordinary skill in the art at the time the invention was made further modify the combination of Takagi, Walker, Bulthuis and Sun with the searching procedure shown by Kek. This modification would have improved the system's efficiency by providing adequate storage capacity to conduct a search over an appreciable period of time as suggested by Kek (column 2).

Claim 14 is rejected for the same reasons as claim 7.

Claim 26 is rejected for the same reasons as claim 7.

Regarding claim 18, see paragraph 0010 of Bulthuis.

Claim 27 is rejected for the same reasons as claim 18.

7. Claims 19, 20, 28 and 29 are rejected under 35 U.S.C § 103(a) as being unpatentable over Takagi combined with Walker, Bulthuis, Sun and Kek in further view of Langhart et al, U.S. Patent Application Publication No. 2003/0012346 (hereinafter Langhart).

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As per claim 19, the primary teachings fail to indicate the translating function is conducted by a text translation service that converts at least a portion of the text data from a first language to a second language. All the same, Langhart explains this feature (see paragraphs 0028 and 0029). Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the primary teachings with the service of Langhart. This modification would have improved the system's convenience by allowing users to view conversation data via a web page.

As per claim 20, the primary teachings fail to indicate the translating function is conducted by an audio translation service that converts at least a portion of the audio data from a first language to a second language. All the same, Langhart explains this feature (see paragraphs 0028 and 0029). Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the primary teachings with the service of Langhart. This modification would have improved the system's convenience by allowing users to view conversation data via a web page.

Claim 28 is rejected for the same reasons as claim 19.

Claim 29 is rejected for the same reasons as claim 20.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 571-272-7533. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone numbers for the

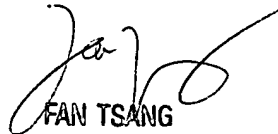
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organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

OA

Olisa Anwah
Patent Examiner
March 22, 2007



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